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Paper No. 18

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In re Application of: Chin et al.)
Application No. 09/476,622)
Attorney Docket No. 884.101US1)
Filed: December 31, 1999)
For: EXTERNAL MICROCODE)

**DECISION ON PETITION TO
WITHDRAW RESTRICTION
REQUIREMENT UNDER 37 CFR
§1.144**

This is a decision on the petition filed May 19, 2003 under 37 C.F.R. §1.144 and 37 C.F.R. §1.181 to withdraw an outstanding restriction requirement.

The petition is **GRANTED**.

RELEVANT PROSECUTION HISTORY

- December 31, 1999 The application identified above was filed with claims 1-20.
- September 27, 2001 A non-final Office action was mailed rejecting claims 1-20 (Paper # 5). The Office action did not include grounds for rejection of claim 10.
- April 8, 2002 An amendment was filed canceling claims 1-9 and 11-20 and adding new claims 21-40 (Paper #7). Claim 10 was amended to independent form by incorporating all of the features of cancelled independent claim 9. Claims 10 and 21-40 were pending. Claims 22-25 were dependent on cancelled claim 1.
- July 16, 2002 A non-final Office action was mailed including (1) election of claim 10 by original presentation, (2) withdrawal of claims 21-40 from consideration as non-elected due to the new claim language "machine specific register" in these claims and (3) a rejection of claim 10, including grounds for rejection (Paper #8).

- October 21, 2002 An amendment was filed adding the “machine specific register” language to claim 10 and requesting reconsideration of the restriction requirement (Paper #9).
- October 28, 2002 A non-final Office action was mailed (1) repeating the explanation of the restriction requirement, (2) further withdrawing claim 10 from consideration and (3) treating the October 21, 2002 amendment as non-responsive for presenting only claims drawn to the non-elected invention (Paper #10).
- December 2, 2002 A paper was filed requesting reconsideration of (1) the restriction requirement and (2) the holding of the October 21, 2002 amendment as non-responsive (Paper #11).
- January 24, 2003 A paper was filed by facsimile requesting reconsideration of (1) the restriction requirement and (2) the holding of the October 21, 2002 amendment as non-responsive.
- January 29, 2003 An Interview Summary form was mailed including a discussion of the restriction requirement, the holding of non-responsive amendment, and requiring one of three options for further prosecution by applicant including (1) filing of new claims, (2) filing a RCE and (3) filing a petition of the restriction requirement (Paper #12).
- February 6, 2003 A non-final Office action was mailed (1) repeating the explanation of the restriction requirement and (2) treating the request for reconsideration filed on December 2, 2002 as non-responsive for presenting only claims drawn to the non-elected invention (Paper #13).
- February 21, 2003 A second copy of the January 24, 2003 paper was filed (Paper #15).
- April 30, 2003 A miscellaneous communication was mailed (on a Form PTO-90C) providing reasons for maintaining the restriction requirement and holding of non-responsive.
- May 19, 2003 A formal Petition to withdrawn the restriction requirement was filed (Paper #17).

REGULATIONS AND PRACTICE

37 C.F.R. § 1.143 states:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

37 C.F.R. § 1.145 states:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

37 C.F.R. § 1.181 states:

- (a) Petition may be taken to the Commissioner:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
 - (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.
- (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and

exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02....

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

DECISION

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner. 37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made.

In the above-identified application, applicant filed several requests for reconsideration prior to the petition of May 19, 2003, in accordance with 37 C.F.R. § 1.143. Although the restriction was never made final in accordance with MPEP § 821.01, the initial restriction requirement was maintained in five subsequent communications. To expedite prosecution of this application, the Office action of July 16, 2002, which maintained the restriction requirement, is being treated as a Final restriction requirement.

The issue presented in the petition is whether the restriction based on original presentation under 37 C.F.R. § 1.145 is proper under the current regulations and practice.

MPEP § 803 sets forth two criteria for a proper restriction requirement between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed and (B) there must be a serious burden on the examiner.

The only claim feature at issue is the limitation “machine specific register(s)”, which was included with new claims 21-40 in the amendment filed April 8, 2002 and added to claim 10 in the amendment filed on October 21, 2002. The examiner withdrew from consideration all claims having “machine specific register(s)” as not having been originally presented.

Thus, to be proper, (A) current claims 10 and 21-40 should be a distinct invention from originally filed claims 1-20; specifically, the “machine specific register(s)” must be patentably distinct from the registers included in original claims 5-8, 11, 12, 15, 16, 18 and 19 and (B) there must be a serious burden on the examiner to search and consider the feature “machine specific register(s)” beyond the search and consideration required for the registers included in original claims 5-8, 11, 12, 15, 16, 18 and 19.

The language “machine specific register(s)” is actually quite broad but is explained, to some extent, in the specification:

Page 1 states: “Different registers may be used for different functions. For example, general purpose registers are used interchangeably to hold operations for logical and arithmetic operations. Special purpose registers may be used for holding status information via various flag bits, for example.”

Page 4, lines 29 et seq., states: “the firmware code 210 implements microcode operations using registers which are specific to a particular machine or to a particular model of a machine. The registers are referred to herein as “Machine Specific Registers.” The machine specific registers function as an interface between the firmware 206 and the processor 204.... For example, an MSR bank may be associated with an external bus unit, while another MSR bank might be associated with the processor’s cache. Each one of the MSRs 208 store one or more bits. The size of an MSR may vary between the functional units.”

It is clear that the only thing that distinguishes the claimed machine specific registers from general-purpose registers is the manner in which they are used. Although the size of the machine specific registers may vary based on the particular application, there is nothing in the *claims* that requires that they have a particular or unique circuit layout or packaging. In other words, the machine specific registers appear to be simply ordinary registers that are used as “dedicated registers” for a particular purpose -- namely to transfer microcode to and from the processor.

That particular purpose for using registers was included in the original claims 6-8, 11, 12, 15, 16, 18 and 19.

Because the *claims* are not limited what is actually meant by “specific”, beyond the purpose for which the registers were used, the examiner would not have been required to search for any particular or unique feature a machine specific register other than the purpose for which it was used. A “specific” implementation of a machine specific register was included on page 7 of the specification, which states, “For example, one bit 412 of the MSR 402 controls the invalidation of a cache line in the L1 instruction cache 406. When the MSR bit four is set to ‘1’, the control logic to invalidate the cache line in the L1 instruction cache is triggered”, however the broad language of the claims does not include such limitations.

Since (1) the purpose for which the machine specific registers are used in the present claims is the same as the purpose for which the registers of original claims 5-8, 11, 12, 15, 16, 18 and 19 were used and (2) there is nothing in the claims to distinguish the machine specific registers from ordinary registers that are used for a particular purpose, the inventions listed in the restriction requirement are not distinct. There would be no serious additional burden on the examiner to consider machine specific registers as they appear in pending claims 10 and 21-40.

For the above reasons, the petition is **GRANTED**.

The restriction requirement is hereby **WITHDRAWN**.

The application will be forwarded to the examiner for consideration on the merits of claims 10 and 21-40.



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